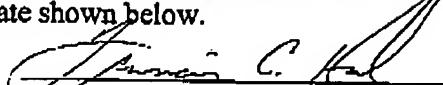


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Francis C. Hand

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Art Unit 3763

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: Williams, Catherine Serke

Application No.: 10/773,538

Filing Date: February 6, 2004

Title: Needle Guard

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Customer No.: 27162

REPLY BRIEF

Sir:

This is in response to the Examiner's Answer dated June 4, 2007.

No request is being made for an Oral Hearing.

The Examiner has raised new issues, namely:

- I. That one skilled in the art can reasonably conclude that the claim language regarding the strip is broad and appellant is arguing that which is not claimed.

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- II. That the Examiner has not applied the standards of 35 USC 102(b) in holding that Wemmert meets the claim limitations.
- III. That one skilled in the art should defer to the specification and not the plain meaning of the term "washer" in claim 3.

I. One skilled in the art can reasonably conclude that appellant is arguing that which is claimed

Appellant's claim 2 is directed to the elected embodiment of Figs.19 to 27. As set forth in the original description at page 4, lines 14 to 16:

—It is an alternate another object of this invention to provide a corrugated strip whose axis is the needle and is strong and resilient to achieve the locking of the needle tip within the plastic housing.—(emphasis added)

Further, as set forth in the original description at page 10, penultimate line to page 11, line 6 (and the Preliminary Amendment thereof):

—As the safety needle housing 101 moves down the needle 12 axis, the Mylar strip 110 unfolds about the needle 12 until it reaches its maximum extension. The Mylar strip's 110 length is such that the housing 101 will enclose the sharpened end of the needle 12 before full extension is obtained. When full extension of the Mylar strip 110 is obtained and the needle 12 is totally within the safety needle housing 101, the user releases the housing 101. At that time there is some retraction of the Mylar strip 110 pushing the needle 12 sharpened point against the "H" shaped lock 102. —(emphasis added)

Claim 2 requires a polyester film strip [e.g. a Mylar film strip] "disposed in corrugated relation" to respond to a withdrawal movement of a needle relative to a housing whereby "... said needle moves into said housing and into abutment with said housing while said strip is stretched between said hub and said housing to retain said housing connected to said hub under a biasing force."

There is a clear teaching in the original description that the corrugated strip 110, e.g. of Fig. 24 of appellant's drawings is **resilient**. That is to say, that the strip 110 can be stretched and can then return to its original shape.

There is also a clear teaching in the original description that, in use, the corrugated strip 110 is "fully extended" and then retracts pushing the needle 12 sharpened point against the "H" shaped lock 102. That is to say, that the strip 110 can be stretched and can then return to its original shape to retain the housing 101 connected to the 19 hub under a biasing force.

Thus, appellant is arguing that which is claimed, i.e. "said strip is stretched between said hub and said housing to retain said housing connected to said hub under a biasing force".

II. The Examiner has not applied the standards of 35 USC 102(b) in holding that Wemmert meets the claim limitations

The Examiner alleges that the term "stretched" as defined by appellant's description should mean that the corrugated strip 110 moves from the folded position of Fig. 27 to the more linear position of Fig. 24. This allegation is unfounded in view of the clear teaching that the strip is **resilient** and, in use, is to be stretched and then is to return to its original shape to retain the housing 101 connected to the 19 hub under a biasing force.

The Examiner fails to apply the standards of 35 USC 102(b). As the courts have held:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.
Verdegaal Bros. v. Union Oil Co. of California,

814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).
See MPEP 2131.

The identical invention must be shown in as complete detail as is contained in the ... claim."

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner agrees that Wemmert does not teach that the tether 44 is stretched between the needle hub 34 and the needle shield 40 to retain the needle shield 40 connected to the needle hub 34 under a biasing force. For this reason alone, a rejection of claims 2 and 3 as being unpatentable over Wemmert under 35 U.S.C. 103 is not in order.

The Examiner has failed to apply the plain meaning of the terms of the claims. As set forth in MPEP § 2143.03, all claim limitations must be taught or suggested and indefinite limitations must be considered. Thus :

A claim limitation which is considered indefinite cannot be disregarded. If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. 112, second paragraph and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984)
In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

The Examiner has not alleged that the term "stretched" is indefinite under 35 U.S.C. 112.

III. One skilled in the art should defer to the plain meaning of the term "washer" in claim 3

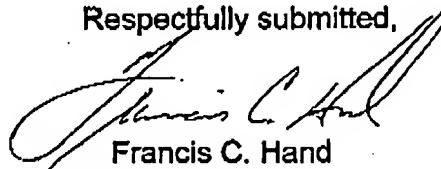
During examination, the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004).

Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. See MPEP 2111.01

The Examiner alleges that the transverse barrier 49 with two lips 49a in the configuration of a duckbill (column 5, ll. 41 to 43) of Wemmert reads on the claimed washer in light of appellant's own description of washer and one skilled in the art should defer to the specification and not the plain meaning. [emphasis added].

The Examiner's position is adverse to the Law and to MPEP 2111.01. For this reason alone, a rejection of claim 3 as being unpatentable over Wemmert under 35 U.S.C. 103 is not in order.

Respectfully submitted,



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